

REMARKS

In regard to section 1 of the office action, the abstract has been amended above to overcome the examiner's objection. This does not narrow or limit the scope of the invention.

Claim 36 has been allowed.

Claims 26 and 32 have been converted from dependent form into independent form. This change in form does not narrow or limit the scope of the claims. The independent claims which claims 26 and 32 were formerly dependent upon have not been cancelled. Therefore, the full scope of the doctrine of equivalents should apply to claims 26 and 32 as if they were originally presented in independent form when the application was filed. In view of section 12 of the office action, claims 26 and 32 should be in condition for allowance.

Claims 1, 3, 6, 8-9, 20, 22, 23-25, 29-30, 33 and 34 were rejected under 35 U.S.C. §102(e) as being anticipated by Misawa et al. (US 2002/0118285 A1). Claim 35 was rejected under 35 U.S.C. §102(e) as being anticipated by Hayduk (US 2003/0054833 A1). Claims 1-3, 6, 8, 11, 15, 17, 20, 23-24, 30-31, and 33-35 were rejected under 35 U.S.C. §102(e) as being anticipated by Nakai et al. (US 2002/0033779 A1). Claims 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Misawa et al. (US 2002/0118285 A1) in view of Reele et al. (US 5,893,037). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Misawa et al. (US 2002/0118285 A1) in view of Kubo et al. (US 2001/0006400 A1). Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nakai et al. (US 2002/0033779 A1) in view of

Horvitz (US 2004/0236719 A1). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Nakai et al. (US 2002/0033779 A1) in view of Schuster et al. (US 6,584,490). The examiner is requested to reconsider these rejections.

Claim 1 has been amended above to clarify applicants' claimed invention. In particular, claim 1 claims that the system for prioritizing prioritizes the user stored files relative to each other based upon a priority value established for the files by a combination of at least two of the different prioritization parameters. This is described in the application, among other places, at page 12. line 11 et seq.

Misawa et al. relates to digital cameras and a priority selection used in those. The publication describes a invention in which a switch is used for selecting priority of an image. The priority value can be 1-3 (Important, normal, memo). That priority value is selected when taking the image and recorded with the image. The priority value is defined based on the user choice (on which position the user has putted the switch), there is also mentioned that a "priority setting device" would analyze the image and, if the image is damaged, the image would have a low priority value automatically.

The invention in applicants' patent application, on the other hand, does not need to use any kind of switch to determine the priority value, and the priority value does not need to be selected at the time of the image taken. More importantly, the priority value is a combination of at least two different prioritization parameters, not based on only one priority

selection (the priority switch) as in Misawa et al. The priority value, which is combination of at least two different prioritization parameters, is clearly stated in the independent claims and, therefore, the claims should be patentable over Misawa et al.

Nakai et al. does not appear to be anything similar to the claimed invention. The examiner is mainly referring to the figures. The text does not appear to include any information on the prioritizing methods or priority value which is a combination of at least two different prioritization parameters. Therefore, the claimed invention appears to be patentable over Nakai et al.

Though dependent claims 2-8 and 10-22 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Claim 23 has been amended to clarify applicants' claimed invention. In particular, claim 23 claims a method comprising prioritizing the user stored files relative to each other based upon a priority value established for each of the files by a **combination** of at least two of the prioritization parameters associated with each of the files. Nowhere in the cited art is there a disclosure or suggestion of prioritizing the user stored files relative to each other based upon a priority value established for each of the files by a combination of at least two of the prioritization parameters

associated with each of the files. Therefore, claim 23 is patentable and should be allowed.

Though dependent claims 24-25 and 28-31 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 23. However, to expedite prosecution at this time, no further comment will be made.

Claim 33 has been amended to clarify applicants' claimed invention. In particular, claim 33 claims a method comprising prioritizing the files relative to one another based upon a parameter value for each file, the parameter value comprising a **combined** single value from the value judgment parameter respectively associated with the files and at least one other of the prioritization parameters respectively associated with the files. Nowhere in the cited art is there a disclosure or suggestion of a parameter value comprising a **combined** single value from the value judgment parameter respectively associated with the files and at least one other of the prioritization parameters respectively associated with the files. Therefore, claim 33 is patentable and should be allowed.

Claim 35 has not been amended above. Claim 35 claims a system comprising means for prioritizing the user stored files relative to each other based upon **both** the second backup parameter and at least one of the first prioritization parameters for each file. The features of claim 35 are not disclosed or suggested in the cited art. Therefore, claim 35 is patentable and should be allowed.

Appl. No.: 10/087,465
Reply to Office Action of: 02/25/2005

New claims 37-42 have been added above to claim the features recited therein.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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5/5/05

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